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The Examiner rejected all original claims as obvious and therefore unpatentable. The examiner asserted that Claims 15, 17-21 and 30-34 were unpatentable over Weiss in view of Brooke (1,996,950). Weiss discloses a paperboard child toilet seat adapter with a box-like fold down flap along the front edge and a box-like fold up flap along the rear edge. Brooke disclosed a sanitary paper liner for covering the toilet seat, with a front flap tucked under the seat, between the seat and toilet bowl rim, to prevent the liner from shifting as the user assumes a sitting position upon it. The examiner asserted that it would have been obvious to combine Brooke's use of a tuck-under front flap with Weiss's paperboard seat. The examiner also asserted that Claims 1-14, 16 and 29 were unpatentable over Weiss in view of the design patent Crossley (D346,206). Crossley was a design for a molded plastic child toilet seat adapter which had handles. Here the examiner asserts that it would have been obvious to combine Crossley with Weiss by putting handles on Weiss's paperboard seat. examiner is satisfied that his assertions constitute a prima facie case for obviousness as required by law. For the following reasons, I disagree.

Although persons may reach different conclusions as to whether an invention is "obvious," the matter is not one where mere opinion carries the day. Instead, and although we question whether the standard of "obviousness" is capable of adequately objective inquiry and reasonably consistent application, the cases are reasonably clear that whether an invention is "non-obvious" must rest upon and be supported by specific inquiries. The law does not support arbitrary

rejections. Specifically, one must inquire into what is relevant prior art, and what is taught in such art(s). These inquiries themselves are not obvious in their content or their application and so the two inquiries are also not matters of opinion and must be addressed in accordance with defined legal principles.

For purposes of reference, chronological, side-by-side listings of references to both adult hygienic liner technology and foldable, weight-bearing child toilet seat adaptor technology is set forth in Appendix A.

## The relevant Prior Art

Neither the Paper-based liners nor the design patent for a molded plastic toilet seat adaptor are analogous arts.

The examiner has assumed that inventions relating to the use of thin paper liners to provide a hygienic barrier for adults using public toilets is analogous to toilet adaptors for children made from firm materials. That assumption is erroneous.

"The test as to whether two references are from non-analogous arts is whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art." In re Shapleigh, 248 F.2d 96, 102 (CCPA 1957).

There are various approaches to determining the "relevant art" found in both treatises and cases. One way is to look at the

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**7**  product's function; another way is to look at the problem to be solved; yet another way is to look at the scientific field involved in the solution. Under all of these approaches, neither the thin paper liner (Brooke) nor the molded toilet adaptor (Crossley) is a source to which one making the instant invention would be expected to turn for guidance.

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## Product Function Analysis

The function of the invention generally and those in the art before it is to provide a portable means to securely seat a small child on an adult-size toilet seat which, being designed for adults, has an opening too large to comfortably accommodate the child. Ιt must bridge the gap, be capable of bearing the child's weight, and remain secure while a potentially fidgeting child is seated thereon. It is a further function of the current invention to meet the foregoing portability objective while being constructed from a single piece of foldable material, which can thus be folded into a smaller and more easily carried package. While it is also a purpose of the invention and its predecessors to provide a clean surface, such function is not significant in the analysis, as any material and any means used to construct the adaptor would satisfy that purpose, and nothing further inventive must be done. Additional issues addressed by the handles are discussed below.

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The function of the invention of Brooke is solely (as is relevant here) to provide a clean barrier for an adult sitting on a toilet.

The thin paper barrier of Brooke could not be used as an adaptor for seating a child as it has no weight-bearing capacity at all.

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27 28 For the child seat, weight-bearing capacity can be achieved either by using a material which is sufficiently firm and strong by its inherent nature, as most of the patents in the field do, or by using a flexible material which can nevertheless support weight when its surface is put under tension. Liners such as in Brooke provide no insight in a weight-bearing context under either approach.

Crossley does not disclose any invention at all, but a design for a non-portable, molded plastic toilet adaptor.

## Problem Solved Analysis

The problem to be solved by the front, fold-under flap in the present invention is to keep the seat secure while the child is seated In this context, the "security" is primarily the prevention from lateral or rotational shifting of the adaptor, so that both of its rear corner edges remain on the seat where they can transfer the force of the child's weight. A child will generally be lifted up and placed upon the adaptor by an accompanying adult, and there is little concern over the adaptor shifting during that process. Further, the preferred material, corrugated paperboard, is of such weight and firmness that airflow resulting from local movement, such as is apt to displace a thin paper liner during the process of an adult sitting, would not be sufficient to disturb the position of the current invention even in the absence of a fold-under flap. To the extent there is such concern, a fold-under flap adds little more than a folddown only flap, which several prior inventions utilize. Similarly, the child will sit with his or her legs over the front of the adaptor

and toilet seat, so there is little concern over the adaptor unduly shifting forward or backward. In Brooke, the problem to be solved by the flap is to keep the liner in place during the act of sitting, which, as stated, is not a concern in the present invention. An adult using a liner would not have concerns over the placement of the liner once seated, as his or her weight would keep the liner in place and, in any event, shifting of the user would cause the paper liner to tear and would not be retained in place by the flap. Thus, the flap in Brooke does not and could not solve the same problem presented in the current invention and therefore would not be a likely source of reference.

This test is not particularly informative for handles, as the concept of handles is not new; but the analysis is presented in the interest of keeping the analysis complete. The problems to be solved by handles in the current invention are: (a) to occupy child's hands to keep them from touching contaminated surfaces in public restrooms; (b) to give the child something to hold so they feel more secure and are, perhaps, amused; and (c) to provide a means for an accompanying adult to remove the adaptor without touching toilet surfaces. As a design only, Crossley does not disclose the purpose for its handles or whether they address any particular problem or issue at all. Although the Crossley handles could arguably address the purpose set forth in (b) and/or (c), as a non-portable adaptor, the Crossley design would be used in a familiar and controllable environment and would not address the concerns in (a).

Under the third approach, we look at the scientific or technical field involved. In the current invention, the field is that dealing with the use and manipulation properties of firm, weight-bearing capable, but foldable, materials, such as corrugated paperboard.

Brooke involved the use of thin paper, which he shows wrapped around the front of the toilet seat in the same manner as one would wrap cloth or other highly flexible material. The manipulation of highly flexible materials such as paper would not serve as a source of reference for the manipulation of firm materials, which cannot be draped around objects as they are found. Firm materials must anticipate the precise manner of fit in advance, so that cuts, scores and folds can be predetermined and incorporated. Similarly, Crossley involved a design for an adaptor made of molded plastic, a process that has virtually nothing in common with manipulating sheets of firm but foldable paperboard.

Even where there is similarity in structure between two arts, if the basic problem to be solved has significant differences, one will not be presumed to serve as a reference for the other. For example, in <a href="Stevenson v. International Trade Comm.">Stevenson v. International Trade Comm.</a>, 612 F.2d 546, 204 USPQ 276 (CCPA 1979), the court said:

"There is similarity in structure, with the waterski, the surfboard, and the kicktail deck all having an unruptured aft plane. However, the problem of maneuvering a wheeled vehicle across a hard surface would appear to differ significantly from the problem of maneuvering a surfboard or waterski through the water, a fluid medium. Therefore... one of ordinary skill in the

art of designing skateboards would not have turned to these patents for guidance on a problem of maneuverability of a wheeled vehicle."

The issue presented by the examiner in the current invention is analogous to <u>Stevenson</u>, <u>supra</u>. There is a significant difference between the problem of creating a weight-bearing adaptor and those of both creating a non-weight-bearing liner and creating a molded plastic seat. The liner and molded arts are not analogous.

The fact that both paper liners and child adaptors are used with toilets does not make the arts analogous.

The fact that paper liners and child adaptors are both used with toilet seats does not make them analogous arts. In <u>In re Clay</u>, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992), the court addressed a patent office rejection based on prior art, finding distinctions in the prior reference notwithstanding that both related to the same industry. The court there said:

"[the reference] cannot be considered to be within [the inventor's] field of invention merely because both relate to the petroleum industry... [the reference] teaches the use of a gel in unconfined and irregular volumes within generally underground natural oil bearing formations to channel flow in a desired direction; [the inventor] teaches the introduction of gel to the confined dead volume of a man-made storage tank. The [reference] process operates in extreme conditions, with petroleum formation temperatures as high as 115 degrees C and at

 apparently operates at ambient temperature and atmospheric pressure. [The inventor's] field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of [the reference] invention, on the other hand, is the extraction of crude petroleum."

significant well bore pressures; [the inventor's] process

Similarly, adaptors which are appropriate mainly for single site use, either because they attach in some manner to the toilet or seat, or because they do not collapse or fold into an area significantly more compact than their "in use" state, are not an analogous art. Such adaptors need not be simple, light, disposable, made of a single sheet of material, or otherwise need to alter their dimension or shape. In fact, they are, by design, <u>not</u> disposable. See, e.g., Zuckerman (1,950,016), Rasmussen (2,255,272), Merry (6,449,780). This group faces none of the engineering challenges faced in portable potty seats and have manufacturing alternatives not available to the current invention and its peers. Crossley belongs to the class of toilet seats designed for use at a single location.

The Examiner's Arguments that it was "obvious" to combine Weiss and Brooke (for front flaps) and Weiss and Crossley (for handles) is not supported by historical fact.

According to the historical and revision notes to 35 U.S.C. §103, "the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850." Thus, the concept of "non-obviousness" which the examiner asserts is not new and has been applied historically.

Weiss was not the first to use a firm foldable material such as corrugated paperboard. Cardboard was suggested in 1951 by Potts/LaRoche. Similarly, a fold-under flap in paper liners was used by Hopkinson in 1912. Thus, if the combination from the two arts is obvious, it has been so since at least 1951. Nevertheless, between the times of Hopkinson and Brooke, fold-under flaps were employed in two other liner-based inventions: Metcalf (1,402,307) and Marks (1,582,527), both in 1922. Neither was denied as obvious in light of Hopkinson; nor was Brooke. Since 1951, there have been at least 7 child toilet adaptor patents granted, none of which employed a fold-under flap or disclosed such a flap as an alternative embodiment.

Brooke, and for that matter Hopkinson, did not teach folding under. Folding under has been around for at least as long as people have been using blankets and tucking the edges under a mattress or other bedding. Hopkinson first employed the same technique in paper toilet liners. The simple recognition that a thin paper sheet can be manipulated like fabric would lead one in that direction. There is no evidence in the historical record that adapting a similar manipulation to a firm foldable surface would be an obvious transition.

Finally, to incorporate a fold-under flap in Weiss, is essentially to ignore Weiss. Once one substitutes a fold-under flap for Weiss's downward box-like front end, he has removed Weiss's innovation (assuming that there was anything new in Weiss at all, which is discussed below) and gone in an entirely different direction. That is no more obvious after Weiss than before it. The firm cardboard seat

with folds along the rear edge were disclosed in Potts/LaRoche. Weiss offers nothing to the current invention.

Similarly, handles are not new and they were not new when Crossley used them on a molded plastic toilet seat adaptor. Crossley teaches absolutely nothing useful in adapting handles to an adaptor made of a single sheet of foldable material.

The examiner's assertion that handles are "obviously" adapted to or combined with Weiss is superficial. The fold-up sides of Weiss are too far rearward to provide handles useful to a child facing forward. The fold-down flaps along the forward portion of the sides are folded down, opposite to the direction handles must go. Although one might suggest that a handle might be made to project from the small space between the two side flaps in Weiss, such a handle would be functionally useless, as it would have only one point of connection with the seat and would therefore provide no stability and be inclined to rip along its score line. Although one might conceive of a way to force handles onto Weiss, such is neither obvious nor practical.

Again, to accomplish that which the examiner asserts is obvious, one must abandon the functional aspects of Weiss for a totally new invention; and nothing supports a conclusion that to do so would be obvious.

## No motivation to combine has been shown by the examiner

In concluding that it would be obvious to combine Weiss with Brooke (for the fold-under flap) and Weiss with Crossley (for

handles), the examiner is relying solely on his own opinion and judgment; he does not cite any reason for referring to those patents, which are not cited in any of the other agreeably relevant patents or legal standards of "non-obviousness" in the patent context. The only basis disclosed for the examiner's conclusion was his opinion of the structural similarity.

If Brooke and Crossley were relevant prior art references for portable child toilet seat adaptors, they would have been cited in prior patents for similar devices, such as Weiss, Potts, Alexander, etc., and particularly Weiss, which the same examiner approved. They aren't cited by any of the clearly relevant prior art patents. Why is it that they were not relevant prior art before, as in Weiss, but have become so now? The only explanation for their reference in this invention and not in the context of Weiss is that the examiner used the instant invention as a reference and specifically sought art with similar structural features—a methodology specifically disapproved by the law.

The theoretical ability to combine parts is not enough. There must be "some motivation or suggestion to combine the references in prior art taken as a whole." <u>In re Beattie</u>, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed Cir. 1992). That knowledge cannot come from the applicant's invention. <u>In re Oetiker</u>, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

The examiner failed to address why references cited constitute relevant art, what each teaches, or what exists in the prior art which would suggest the combination of the various elements found.

He merely points to structurally similar components and asserts that their combination is obvious. This is directly in conflict with patent law. "Prior art may not be gathered with the claimed invention in mind." Pentec v. Graphic Controls, 776 F.2d 309, 227 USPQ 766 (Fed Cir. 1985).

"[D]ecomposing an invention into its constituent elements, finding each element in prior art and then claiming that it is easy to reassemble these elements into the invention, is a forbidden <a href="ex-post">ex-post</a> analysis." <a href="In-re-Mahurkar Patent Litigation">In-re-Mahurkar Patent Litigation</a>, 831 F.Supp 1354, \_\_\_\_, 28 USPQ2d 1801, \_\_\_\_\_ (N.D. Ill. 1993). <a href="See also, Interconnect Planning">See also, Interconnect Planning</a> Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985), <a href="In-re-Fritch">In-re-Fritch</a>, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

An Historical Analysis demonstrates that the examiner's application of a "non-obvious" standard is flawed.

If the examiner's analytical approach were valid and consistent with the patent law, one would expect that it would apply retrospectively and consistently to the body of patents claimed analogous. Looking back on the evolution of patents in the two arts, it becomes clear that the examiner's approach does not so apply. There are two possible reasons for that result. One is that the analytical approach utilized by the examiner in the instant patent

application is flawed either in foundation or in its specific application here. The other is that the nature of the non-obvious requirement is so incapable of objective and consistent application as to suggest its own invalidity as inherently denying equal protection to patent applicants. As a lay person in the patent world, I am inclined to believe that both are true. In any event, I will address the result rather than the reason, as either reason militates against rejection of the instant application.

Using the Examiners reasoning, the following represent some of the most obvious inconsistencies:

- 1. Weiss would not be allowed in light of Reid (downward, box-like front and side folds), Potts (upward, box-like, rear and side folds), and Alexander (stability from wedging toilet seat into downward front and side folds of cover).
- 2. Greenwood would not be allowed in light of Becker (folding cover in 4 sections, 3 hinges), Dahle, Breher and Fox.
- 3. Montaldo would not be allowed in light of Schrader.
- 4. Hamilton would not be allowed in light of Oakes (adapting weight-bearing surface) Young (front flap), and Becker (securing clips).
- 5. Assuming Hamilton was nevertheless allowed, Hawkins would not be allowed in light of Hamilton (using a flexible material over the front half of the toilet seat to adapt a child) and Marks (securing a flexible material by folding the same around the edges of the toilet seat).
- 6. Brooke would not be allowed in light of Hopkinson (front flap folded under front of toilet seat).

1	7. Reeves would not be allowed in light of Young (both internal lip
2	and rear flap).
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4	That all of the foregoing patents were granted further suggests that
5	the examiner's approach cannot be correct.
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7	CONCLUSION
8	For the foregoing reasons, the examiner's conclusion that the
9	instant invention is obvious is not well taken and the patent
LO	application ought be allowed.
۱1	An opportunity for an interview is requested before any adverse
.2	action is taken hereon.
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L4	Respectfully submitted
L5	
L6	Date: 4/1/05
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APPENDIX 1

1921- Young (1,377,541): a paper-based membrane/liner which contained a front flap resting outside the toilet and an internal flap resting inside the forward edge of the toilet and liner opening, thereby holding the liner in place. 1922- Metcalf (1,402,307): a paper cover of triangular shape, wherein the corners are folded under the toilet seat. 1922- Reid (1,522,699): a paper-based membrane/liner which contained front and side flaps (flanges) folded down to form a box-like cover over the front face and side faces of toilet seat. 1922- Marks (1,582,527): a paper-based membrane/liner which contained side extensions to fold under the side of the seat. 1926- Becker (1,592,597): a cardboard ring covering the toilet seat, subdivided into 4 sections for folding by 3 hinged divisions. The cover is secured by spring clips fitting around the underside of the sides of the toilet seat. 1927- DeLuna (1,635,072): a paper or 1927- Noble (1,633,222): an 8-part hard cardboard ring covering the toilet seat, material adult or child toilet seat with internal flaps and secured by clips forming a ring via 4 hinges and 4 tongue at the "corners." and groove joints. 1927- Mahoney (1,643,413): a continuous sectional ring cover formed by stitching an upper fabric layer and a lower waterproof layer, with sectional pockets into which are inserted stiffer material such as cardboard, thereby providing a comfortable surface which can be removed and folded for carriage. 1928- Engalitcheff (1,673,622): a paper

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cover which, when set for use, has a center portion which extends down into

the bowl to prevent splashing from solid waste and which enables the cover to be drawn into the bowl and washed out during flushing.

1929- Hamilton (1,733,080): a flexible, but durable liner, such as rubber, extended across the forward half of the toilet seat and secured by hooks/clips at the front and side to secure and provide tension to the membrane, and containing a front flap.

1929- Hawkins (1,710,620): a flexible, but durable membrane, such as fabric, covering the top of the toilet seat with the fabric membrane extended to form a flange that wrapped around the edges of the seat and was held in place by tension derived from a strap and buckle. The tension on the membrane provided support for the child.

1930- Oates (1,776,333): paper liner with central portions which tear leaving a strip hanging into interior side of bowl, so that flushing water will pull it in and dispose of the line during flushing.

1935- Brooke (1,996,950): paper-based membrane/liner used for covering the toilet seat, with a forward extension that folded under the front of the seat.

1941- Richardi (2,260,404): used a firm paperboard material as a "simpler" membrane/liner technology which required special adaptation of the toilet seat to accept the replaceable liners.

1943- Reeves (2,312,589): a paper or other cellulosic material ring membrane/liner having a lip extending into the bowl from the front inside portion of the surface and a rear flap extending up.

1944 (filed) - Dahle (2,443,068): a folding adaptor seat, subdivided into 4 sections for folding by 3 hinged divisions.

1947- Richards (2,457,726): a hinged toilet seat made of firm material such as wood or plastic, subdivided into 4 sections for folding by 4 hinged divisions. Although the patent does not indicate its fit over adult-sized seats, it does suggest that it is "particularly advantageous for infants and small children," suggesting that application.

1951- Anderson (2,537,504): a hinged twopiece hard surface folding child adaptor which attaches to and becomes the handles for a carrying bag for other articles.

1951- Potts/LaRoche (2,548,238): uses firm paperboard (or corrugated paper) made from a single blank as a weight-bearing adaptor for child use of adult-sized toilets. Vertical rear and side extensions are used and folded into place in a manner disclosed for knockdown paper boxes in Craw (564,594). A front flap extension is also provided, as is a strap for securing the adaptor to the toilet.

1953- Mohun (2,742,650): an adaptor comprised of upper and a lower layers of plastic sheeting, with sectional pockets into which are inserted stiffer material, thereby providing a firm surface which can be removed and folded for carriage. Longitudinal support is provided by the engagement of interlocking members which, when engage, prevent folding along the longitudinal axis.

1955- Wendel (2,716,244): a cardboard blank as a disposable adaptor. It included a short front fold without sides. It did include additional folds at the rear corners to inhibit both

lateral and forward movement of the blank, and use of the cutout center as a forward splash guard.

1957- Schrader (2,888,686): a woven fabric sleeve fits over the conventional toilet seat, providing a smaller opening, and is secured by lateral straps under and to the rear of the seat.

1958- Alexander (2,825,070): a "triangular" (with the front corner cut off) cardboard or corrugated version with sides angled from a wider back to a narrower front, and folded edges which wedge the front and front portion of the sides of the toilet between the front and side folded flanges of the seat.

1967- Montaldo (3,316,560): a pliable plasticine envelope completely surrounding the top, bottom, front and sides of the toilet seat (open only in the rear to allow it to slip over the seta), with central cutouts in the top and bottom sheets, with rear snaps to close the envelope.

1985- Bass (4,525,880): a thin shell that fits over the toilet seat having a stack of internal paper liners to prevent direct contact between the shell and the toilet seat, one of which liners can be removed and disposed of after each use.

1991- Greenwood (5,005,223): a folding adaptor seat, made of plastic, subdivided into 4 sections for folding by 3 hinged divisions.

2002- Weiss (6,473,911): uses firm paperboard (or corrugated paper) made from a single blank as a weight-bearing adaptor for child use of adult-sized toilets. Upward rear and side extensions

are used and folded into place in a manner disclosed for knockdown paper boxes in Craw (564,594). Downward front and side extensions are used and folded down to form a box-like cover over the front face and side faces of toilet seat.